

Remarks

By the foregoing Amendment, the specification is amended to correct a clerical error. No new matter is added by this Amendment. Entry of the Amendment, and favorable consideration thereof, is earnestly requested.

Paragraph 0030 of the specification has been amended to correct a typographical error.

The Examiner has rejected independent claim 1 (under 35 U.S.C. 35 U.S.C. §103 as obvious over Behrens, U.S. Patent No. 5,334,192, at the time of the invention in view of Serbousek et al., U.S. Patent No. 6,066,142. This rejection is respectfully traversed.

Novelty

Behrens does not anticipate claim 1 because all of the elements in claim 1 are not shown in either of this references. At the very least, and as noted by the Examiner, Behrens does not disclose the claimed locking mechanism.

Obviousness

Additionally, neither Behrens nor Serbousek renders claim 1 obvious in view of the other, for several reasons. As a preliminary matter, Applicant notes that, in order for

the claimed invention to be obvious over the prior art, there must be some suggestion or motivation in the prior art to make the relevant combination. See, e.g., MPEP 2143.01 (“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art “may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so.”). This suggestion cannot come from the Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to combine must be found in the prior art, not the applicant’s disclosure). Here, neither Behrens nor Serbousek suggests the desirability of locking the sleeve within to prevent longitudinal movement therethrough. Behrens makes no reference to any type of mechanism for partially blocking the channel at all, and the mechanism in Serbousek is for adapting the size of the guide apparatus to different plates (14), not for preventing longitudinal movement of a sleeve. Applicant respectfully submits that these references simply do not suggest the desirability of performing the longitudinal motion-inhibiting function that is performed by the structure of the presently claimed invention.

Moreover, Behrens specifically teaches away from using any such locking mechanism, as it specifically teaches to use a clamp to fix a drill sleeve in one of the bores. See *Behrens*, Fig.2; Col.4, Ins. 3-22. Accordingly, one would have no reason to

employ a locking mechanism such as that of the claimed invention for selectively inhibiting longitudinal motion through the channel.

Most significant, however, is that, even if the Behrens and Serbousek references were combined, one would still not arrive at claim 1. Instead, several limitations of claim 1 would still be missing. This is because, contrary to the suggestion made in the Office Action, Applicant respectfully notes that Serbousek does not disclose the locking mechanism recited in claim 1. Specifically, Serbousek does not disclose:

- “*at least one sleeve... comprising a plurality of ridges*”
- “*a locking mechanism... wherein said locking mechanism comprises a wall member having a plurality of apertures corresponding to the plurality of channels, such that, when said at least one sleeve is disposed in at least one of the channels and said wall member is in a first position, a portion of said wall member is disposed between at least two of the ridges, thereby inhibiting said at least one sleeve from being longitudinally moveable within at least one of the channels, and, when said wall member is in a second position, said at least one sleeve is longitudinally moveable within at least one of the channels*”

The guide apparatus 310 with telescopic mechanism 318 is a fundamentally different device than the structure of the presently claimed invention. First, Serbousek does not disclose a sleeve with a plurality of ridges. Though the Office Action identifies the “plurality of ridges” (396) in Serbousek, these “ridges” are part of the locking bar (318), not the sleeve. In claim 1, however, it is the sleeve that includes the plurality of ridges, between which the wall member is moveable in order to lock/unlock the sleeve. Similar, it is because of this basic difference that Serbousek also does not disclose a

locking mechanism with a wall member that is disposed between the ridges of the sleeve when in a first position. In fact, the mechanism (318) has nothing to do with inhibiting/allowing longitudinal movement of the sleeve at all, but rather, adjusts the lateral distance between the drill and tap towers (20, 21) by accommodating different plates 14.

Finally, the mechanism (318) of Serbousek does not include "a wall member having a plurality of apertures corresponding to the plurality of channels." Though the Office Action identifies the lock slots (80), these, of course, do not correspond to sleeve channels, but rather, are simply slots that engage and disengage portion 108 of shaft 86 in order to stop/allow the lateral movement of the lock bar 60 (see Fig. 4).

It is respectfully submitted that claims 1-11 and 14-23, all of the claims remaining in the application, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,

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